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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|-----------------------|-------------------------|------------------|
| 10/074,194   | 02/12/2002  | Cristina M. Rondinone | 6792.US.01              | 4364             |
| 23492  | 7590        | 05/05/2004            | EXAMINER                |                  |
| STEVEN F. WEINSTOCK<br>ABBOTT LABORATORIES<br>100 ABBOTT PARK ROAD<br>DEPT. 377/AP6A<br>ABBOTT PARK, IL 60064-6008 |             |                       | FREDMAN, JEFFREY NORMAN |                  |
|  |             |                       | ART UNIT                | PAPER NUMBER     |
|  |             |                       | 1637                    |                  |
| DATE MAILED: 05/05/2004  |             |                       |                         |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/074,194             | RONDINONE ET AL.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jeffrey Fredman        | 1637                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 March 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>March 11, 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-12 in the paper filed March 11, 2004, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al (US 2002/0051786 A1).

Kahn et al teaches a method of claims 1, 5 and 9, for identifying a test compound which inhibits protein tyrosine phosphatase 1B (PTP1B) expression in liver or fat of a non-human mammal (see claim 20 and page 3, paragraph 0050)(see page 10, lines 10-14 of the provisional), the method comprising the steps of:

(a) treating an insulin resistant non-human mammal with said test compound for a time and under conditions sufficient to allow for a change in the level of expression of

at least one of PTP1B mRNA or protein in the liver or fat of said mammal (see claim 20 and page 3, paragraph 0050)(see page 10, lines 10-14 of the provisional),

(b) removing the fat or liver from said mammal (see claim 23 and page 3, paragraph 0054, which refers to analysis of fat and liver)(see page 1, line 16 of provisional, which teaches the effect of compounds that treat diabetes on liver);

(c) detecting the levels of phosphotidylinositol-3-kinase p85 $\alpha$  and p50 $\alpha$  and/or p55 $\alpha$  isoforms in said liver or fat (see claim 20 and page 3, paragraph 0050, where all three of p85 $\alpha$  and p50 $\alpha$  and p55 $\alpha$  are mentioned)(see page 10, lines 10-14 of provisional which refers to p85 $\alpha$  expression with regard to drug screening); and

(d) determining whether the test compound inhibits at least one of PTP1B mRNA or protein in said liver or fat based upon the levels of p85 $\alpha$  and p50 $\alpha$  and/or p55 $\alpha$  detected in said liver or fat (see claim 20 and page 3, paragraph 0050, where all three of p85 $\alpha$  and p50 $\alpha$  and p55 $\alpha$  are mentioned)(see page 10, lines 10-14 of provisional).

With regard to claims 2, 6, 10, Kahn teaches screening in mice (see page 4, paragraph 0061)(see page 10, lines 10-14 of the provisional where mice are also used).

With regard to claims 3, 7, 11, Kahn teaches agents including peptides, small molecules and antibodies (see claim 25)(see page 2, lines 5-8 of the provisional).

With regard to claims 4, 8, 12, Kahn teaches antisense agents (see page 6, paragraph 0086)(see page 2, lines 26-30 of the provisional).

Because the Kahn reference is a Pregrant publication which relies upon the provisional application to have priority over the current claim, the second parentheses points out basis in the priority document.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637